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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER	
GARG, YOGESH C	

ART UNIT	PAPER NUMBER
3625	

DATE MAILED: 10/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/889,022	MORITA ET AL.	
	Examiner	Art Unit	
	Yogesh C. Garg	3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *25 March 2002*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-21* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-21* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *10/2/02&12/13/04*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Specification

1. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2.1. Claims 1-7 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "the apparatus" in line 3 of claim 1. There is insufficient antecedent basis for this limitation in the claim. Since the dependent claims 2-7 inherit the same deficiency they are also rejected.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claim 1 is rejected under 35 U.S.C. 102(e) as being anticipated by Stebbings (US Patent 6,564,253 B1).

Regarding claim 1, Stebbings discloses an information processor which checks out an content to an external device connected thereto or checks in a content from an external device connected thereto (See Figs.12 & 13 wherein the disk controller "78" in fig.12 and computer "58" I fig.13 can check in content from an external device as shown in Fig.10, that is from ISP website and check out content to an external devise, such as CDR, CDROM etc.), the apparatus comprising:

a title display means for displaying a title corresponding to the content (see Figs 12 and 13 wherein Display means "83" in fig.12 and monitor "69" in Fig.13 correspond to the claimed display means for displaying titles related to a content; and

a number of checkouts display means for displaying a number of possible checkouts for the content (The systems shown in figs. 12 and 13 include Display interface "82" and display means "83" or "69" which are capable of displaying a number of possible checkouts for the content, see also col.10, lines 27-34, "....Internet uses, may include, 'listen once'... ...'copy once'...copy thrice'...").

Note: Claims Directed to an Apparatus must be distinguished from the prior art in terms of structure rather than function, *In re Danly* 263 F.2d 844, 847, 120 USPQ 582,

531 (CCPA 1959). A claim containing a " recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. Ex parte Masham, 2 USPQ2d 1657 (bd Pat. App. & Inter. 1987). Thus the structural limitations of claim 1, that is display means for displaying title of the content and display means for displaying a number of possible checkouts for the content are disclosed in Stebbings, as described above. The intended use of the display means for displaying a title or a number of possible checkouts for the content in the claimed apparatus does not differentiate from the prior art apparatus in Stebbings. The same rationale would apply for the rest of the dependent apparatus/system claims.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

10.1. Claims 2-5, 7, 8-13, 15-19 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stebbings in view of Ronning (US Patent 5,883,954) and further in view of Stefik et al. (US Patent 6,925,448 B2), hereinafter Stefik..

Regarding claim 2, it is already analyzed above that Stebbings teaches a display means with the intended use of displaying title of digital content and also number of possible checkouts. Stebbings' invention and disclosure are directed to control and monitor the predefined usage rights of downloaded music or other digital data (see at least col.10, lines 27-33). Stebbings does not teach explicitly displaying the number of possible checkouts, that is the possible allowable downloads/copies left for the music/digital content by a predetermined symbol. However, in the same field of endeavor, that is monitoring and controlling of usage rights of downloaded content, Ronning teaches on the display means possible allowable samples of downloaded digital data left (see at least Fig.3, " 9 Samples Remaining" , Gig.7, " 118-Set up Sample counter", Fig.8 showing setting up different Sample count files regulated by usage rights, Fig.15 shows decreasing the sample counts as they are being used) as per the usage rules. Note: displaying the possible samples of the downloaded or regulated digital data in Ronning is equivalent to the claimed limitation of displaying the possible checkouts of the digital content because in both cases the hardware and software sets

a count manager for controlling the usage of a downloaded data in the form of using it as a sample or copying it or downloading it to another device. Ronning does not teach using symbol to display the usage rights, such as remaining samples to be used or possible downloads/loans to other devices. However, Stefik, in the same field of endeavor, that is monitoring and controlling of usage rights of downloaded content, teaches using symbols/codes to denote the manner of use/usage rights, such as remaining samples to be used or possible downloads/loans to other devices (see at least Abstract, col.3, line 60-col.4, line 7, col.17, line 12-col.21, line 14, claims 1, 19 and 38. See, for example, col. 18, lines 30-41, "Grammar element 1505 "Transport-Code:=[Copy.vertline.Transfer.vertline.Loan [Remaining-Rights: Next-Set-of-Rights]] [(Next-Copy-Rights: Next-Set of Rights)]" . Here, the Transport symbol/code is indicative of useable rights allowing the making of persistent, usable copies of the digital work on other repositories, determining the rights on the work after it is transported. If this is not specified, then the rights on the transported copy are the same as on the original. The optional Remaining-Rights specify the rights that remain with a digital work when it is loaned out. If this is not specified, then the default is that no rights can be exercised when it is loaned out. Therefore, in view of Stefik in the same field of endeavor, that is monitoring and controlling of usage rights of downloaded content, it would be obvious to one of an ordinary skilled in the art to use predetermined symbols in the combined teachings of Stebbings/Ronning to denote the manner in which the useable rights can be used because using the grammar of symbols for denoting usage rights makes it convenient to define various forms of usage rights (see Stefik, col.17, lines 12-22).

Regarding claim 3, Stebbings/Ronning/Stefik discloses that the apparatus according to claim 2, further comprising: an content setting means for setting the content which is to be checked out; a display controlling means for changing, when the content setting means has the content which is to be checked out, the existing number of possible checkouts to a one for the content set by the content setting unit and displaying the new number; and a check-in or checkout means for checking out the content set by the content setting means to an external device connected to the apparatus (see at least Stebbings, col.9, lines 25-35 and col.10, lines 27-34 which teach means to set and control the content to be checked out to an external device connected to the apparatus, such as a Floppy disk, CD-ROM, etc,, see Fig.12. Stefik, as analyzed above in claim 2, discloses the monitoring and controlling of the possible checkouts which can be displayed on the Display screen (Stebbings, Fig.12) via Display Interface (Stebbings Fig.12) controlled by the disk Controller (Stebbings Fig.12) . Stefik also discloses changing the counts, that is displaying a decrement sample discount on using a useable count (see Stefik, Fig.15 and col.9, lines 38-49). In view of Ronning/Stefik, it would be obvious to one of an ordinary skilled in the art to use the concept that the system decrements the sample count and displays the decreased sample count in conformity with the predetermined usage rights and also alerting the user about the remaining useable rights left and prompting him to take action to extend or not those rights.

Regarding claims 4-5, 7, 8-13, 15-19 and 21, their limitations are closely parallel to the limitations of claims 1-3 and are therefore analyzed and rejected as being unpatentable over Stebbings/Ronning/Stefik on the basis of same rationale used for claims 1-3.

10.2. Claims 6,14 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stebbings/Ronning/Stefik and further in view of Acres (US Patent 6,319,125 B1)

7. Regarding claims 6, 14, and 20, Stebbings/Ronning/Stefik teaches an information processor, a method for processing information and a computer program for processing checkouts and checkins of digital content to or from external device controlled by predetermined usage rights, as analyzed above for claims 1-3, 8 and 15. Stebbings/Ronning/Stefik as applied to claims 1-3, 8 and 15 does not disclose that in the number of checkouts displaying step, a number of possible checkouts is displayed by a predetermined kind of musical-note. The examiner would like to make a note that using a sound alert with a particular musical note is a very well known phenomenon to alert an user about a particular computer event, such as imputing wrong entry, end of a session or alerting about an incoming e-mail, etc. It has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, the prior art of

Acres is reasonably pertinent to the particular problem of using a sound alert to indicate to the user that the displayed decremented bonus has been decremented to less than one credit and that he is required to earn more welcome back bonus points (see Acres, col.11, lines 44-57) which is similar to the problem with which the applicant was faced in using a predetermined kind of musical note denoting the number of remaining checkouts left, such as Zero or one checkout. In view of Acres, it would be obvious to one of an ordinary skilled in the art at the time of the applicant's invention to have included the feature of using a predetermined sound alert, that is a musical note to denote the end of possible samples/downloads or one possible sample/download so as to prepare the user for future action.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

(i) Iwamura (US Publication 2002/0161716 A, see at least paragraphs 0035, 0054) and Ginter et al. (US Patent 6,389,402 B1, see at least col.270, lines 23-45)discloses a method and apparatus for checking and checkouts of contents from and to external devices and also means to display the usage rights and the balance usage rights.

(ii) Ishiguro et al. (US publication 2002/0194475 A1, see Abstract), Medina et al. (US Patent 6,959,288, see col.1, line 58-col.2, line 34, col.9, lines 21-34, col.12, line 5-

col.14, line 48) and Peinado et al. (US Patent 7,103,574, see Abstract) a method and apparatus for checking and checkouts of contents from and to external devices and also means to monitor and control the distribution of the content as per predetermined usage rights.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yogesh C. Garg whose telephone number is 571-272-6756. The examiner can normally be reached on Increased Flex.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith can be reached on 571-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Yogesh C Garg
Primary Examiner
Art Unit 3625